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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TATSUO EGUCHI, YASUHIKO TERASHITA,
YASUO NOMURA, YASUSHI MIYAJIMA, YOSHIKAZU WATANABE,
NOBUAKI YAMAGUCHI, KUMIKO SASAKI, MAKOTO NIJIMA,
AL SUZUKI, SHINYA FUJI, and YUSUKE TANI

Appeal 2010-006340
Application 09/720,537
Technology Center 2400

Before ALLEN R. MacDONALD, ROBERT E. NAPPI, and
ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 15-30. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim(s)

Exemplary independent claim 27 under appeal reads as follows:

27. A tangible computer readable medium configured to control a computer to execute an information processing method comprising:

storing a program table simultaneously displaying a plurality of programs with respective additional request buttons for record reservation data, such that each displayed program has its own corresponding unique request button for record reservation data simultaneously displayed with the respective displayed program, selection of a respective of the request button for record reservation data directly generating recording reservation data for the corresponding displayed program;

allowing a user to select programs on the program table by selecting one of the respective request buttons for record reservation data on the program table corresponding to a respective program, the user accessing the program table from a remote device through a network; and

transmitting record reservation data to the remote device of the user upon the user selecting at least one of the additional request buttons for record reservation data in the program table, and based on the user selections of the at least one of the additional request buttons for record reservation data in the program table, the transmitted record reservation data for controlling the recording of a picture at the user remote device, and including data for specifying a channel, data indicating the date and time for starting the recording, and data indicating the data and time for terminating the recording to a picture recording apparatus.

Rejections on Appeal

The Examiner rejected claims 15, 16, 19, 20, 23, 24, 27, and 28 under 35 U.S.C. § 102(e) as being anticipated by Daniels (US 2002/0032907 A1; Mar. 14, 2002).¹

The Examiner rejected claims 17, 18, 21, 22, 25, 26, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Daniels and the vCalendar Specification; 1996.²

The Examiner rejected claim 27-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting claim 15 under 35 U.S.C. § 102(e) because:

In the claimed inventions an EPG (Electronic Program Guide) to display a screen such as shown for example in Figure 16 is sent by an external apparatus (a server). Such a display is a program table simultaneously displaying programs each with its own additional respective unique request button for record reservation data 251. That is, a different request button for record reservation data 251 is provided for each respective individual program to allow selecting of the individual programs, all of the record reservation data buttons 251-1 to 251-11 being simultaneously displayed with their respective programs.

(App. Br. 8)(Emphasis omitted) and;

¹ Separate patentability under 35 U.S.C. § 102 is not argued for claims 16, 19, 20, 23, 24, 27, and 28.

² Separate patentability is not argued for claims 17, 18, 21, 22, 25, 26, 29, and 30.

Daniels does not disclose or suggest that any program table simultaneously displays a plurality of programs each with its own respective unique request button for record reservation data. Again with reference to Figure 16 in [Appellants'] . . . specification as a non-limiting example, a display according to the claimed inventions simultaneously displays a plurality of programs each with its own additional respective unique request button for record reservation 251.

(App. Br. 9)(Emphasis omitted).

2. At page 7 of the Appeal Brief, Appellants contend that the Examiner erred in rejecting claim 27-30 under 35 U.S.C. § 101 because:

Applicants traverse that rejection and draw attention to the specification at page 56, lines 5-13, which clearly sets forth a tangible computer readable medium. The claims have been amended to be directed to such a tangible computer readable medium, and not to the signal noted in the specification at page 56, fourth paragraph that the Office Action relies upon. Applicants submit the outstanding rejection under 35 U.S.C. § 101 is improper as it ignores the limitations introduced into claims 27-30 and attempts to read claims 27-30 on a disclosure to which the claimed features are not directed.

Issues on Appeal

Did the Examiner err in rejecting claim 15 as being anticipated because Daniels fails to disclose the argued claim limitation?

Did the Examiner err in rejecting claims 27-30 as being directed to non-statutory subject matter?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred.

We agree with the Appellants' contention 1 above. Therefore, Appellants have established that the Examiner erred with respect to the rejection of claims 15, 16, 19, 20, 23, 24, 27, and 28 under § 102(e) and claims 17, 18, 21, 22, 25, 26, 29, and 30 under § 103(a).

We disagree with Appellants' conclusion 2 above. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusion reached by the Examiner.

Appellants' Specification at page 56 describes the medium. Appellants indicate the program can be furnished in a pre-installed state on a hard disk and alternatively indicate several other forms of storage medium. These storage medium embodiments are statutory subject matter and if claims 27-30 were limited to those embodiments, they would be directed solely to statutory subject matter.

However, Appellants' page 56 also indicates that the medium could be a radio path, and could be through a network so it could be stored later. The key sentence here is the one that concludes this discussion in Appellants' Specification. "The meaning of the medium in the specification is to be construed broadly to comprise all these mediums." The result is that Appellants have disclosed both storage mediums and transmission mediums.

Guidance from the Director makes clear that following *Nuijten*,³ if “medium” claims are not limited to a “non-transitory tangible media” (i.e., a tangible article such as a storage media), then they also encompass “transmission media” and the Examiner should make a § 101 rejection.⁴ Although Appellants claims require that the medium be “tangible,” these claims do not require that the medium be an “article” as discussed in *Nuijten*.

We conclude that claims 27-30 are directed to non-statutory subject matter, but can be rendered statutory under 35 U.S.C. § 101 by limiting these claims to a “storage medium”.

CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claims 15, 16, 19, 20, 23, 24, 27, and 28 as being anticipated under 35 U.S.C. § 102(e).

(2) Appellants have established that the Examiner erred in rejecting claims 17, 18, 21, 22, 25, 26, 29, and 30 as being unpatentable under 35 U.S.C. § 103(a).

(3) The Examiner did not err in rejecting claims 27-30 as being unpatentable under 35 U.S.C. § 101.

(4) On this record, claims 15-26 have not been shown to be unpatentable.

(5) Claims 27-30 are not patentable.

³ *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007).

⁴ 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); *Subject Matter Eligibility of Computer Readable Media*.

DECISION

The Examiner's rejection of claims 15, 16, 19, 20, 23, 24, 27, and 28 as being anticipated under 35 U.S.C. § 102(e) is reversed.

The Examiner's rejection of claims 17, 18, 21, 22, 25, 26, 29, and 30 as being unpatentable under 35 U.S.C. § 103(a) is reversed.

The Examiner's rejection of claims 27-30 as being unpatentable under 35 U.S.C. § 101 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). See 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED-IN-PART

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